REMARKS/ARGUMENTS

Reconsideration and allowance of the present application based on the following remarks are respectfully requested.

Claims 1-17 remain pending.

All claims are finally rejected as being anticipated, under 35 U.S.C. §102(b), by WO 95/10555[1] (WO 555), for essentially the reasons of record.

Applicants respectfully submit that the disclosure of WO 555 has been misconstrued and one skilled in the art reading the disclosure would not find a description, explicit or inherent, of a moisture-activated adhesive composition having a total ethylene oxide content, relative to the total adhesive composition, of more than 2.5%.

Applicants agree that WO 055 discloses that the polyol reactant may have an ethylene oxide content of as low as 1% or as high as 90%. It is further agreed that WO 555 discloses that component (b), the aliphatic tertiary amine-initiated polyol component, is present in the composition in an amount of about 1 to about 30%.

However, it is not agreed that these disclosures, taken together, mean that the ethylene oxide content in the adhesive of WO 555 can include up to 27% ethylene oxide based on the total weight of the adhesive.

The disclosure at page 8, lines 12-14 is that the ethylene oxide content refers to the amount of ethylene oxide used in the preparation of component (b). It does not necessarily follow that the amount of ethylene oxide actually incorporated in the aliphatic tertiary amine-initiated polyol component is in the range of about 1 to about 90%.

However, regardless of the amount of ethylene oxide incorporated in the component (b), it does not follow that the practitioner reading the disclosure of WO 555 would understand the amount of component (b) in the composition applies to the entire range of the ethylene oxide content in the ethylene-diamine-based polyol. For example, the lowest possible amount of ethylene oxide, following the Examiner's rationale, would be 0.01% (1% x 1%).

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[1] U.S. Patent No. 6,368,714, issued April 9, 2002, is based on an application filed as a continuation-in-part of Application SN 08/136,359. WO 555 claims priority from the application SN 08/136,359. A copy of U.S. 6,368,714 is enclosed. The disclosure of the U.S. patent is virtually identical to the disclosure of WO 555.

Please note that the disclosure at page 8, lines 1-6 is based only on the "total amount of isocyanate and polyol in the composition" and is not based on the total of the adhesive composition which can also include, *e.g.,* high amounts of fillers, as shown in examples, diluents, wetting agents (*see,* page 10, lines 3-11).

It is further respectfully submitted that it is not proper to look at the broad disclosure of a range of the amount of ethylene oxide in a starting reactant, and the broad disclosure of a range of amounts of a component formed from that starting reactant, and derive a possible range of amounts of ethylene oxide in the composition, as a whole. This is especially so where, as here, the reference itself does not suggest any minimum amount of ethylene oxide in the component, much less in the composition as a whole, while at the same time, ignoring the exemplary embodiments of the examples. In this regard, as previously explained, the maximum amount of the ethylene oxide groups in the examples is only about 2.2%.

As explained in MPEP § 2131.03 "Anticipation of Ranges" (Rev. 1 Feb. 2003, page 2100-73),

> "When the prior art discloses a range which touches, overlaps or is within the claimed range, but no specific examples falling within the claimed range are disclosed, a case by case determination must be made as to anticipation. In order to anticipate the claims, the claimed subject matter must be disclosed in the reference 'with sufficient specificity to constitute an anticipation under the statute.' What constitutes a 'sufficient specificity' is fact dependent. If the claims are directed to a narrow range, the reference teaches a broad range, and there is evidence of unexpected results within the claimed narrow range, depending on other facts of the case, it may be reasonable to conclude that the narrow range is not disclosed with 'sufficient specificity' to constitute an anticipation of the claims. The unexpected results may also render the claims unobvious. The question of 'sufficient specificity' is similar to that of 'clearly envisaging' a species from a generic teaching (citation omitted)."

It is respectfully submitted that the present case is one where the facts require a conclusion that the disclosure of the "calculated" range of 0.01 to 27%, coupled with examples having a maximum ethylene oxide content of 2.22%, does not anticipate the claimed invention claiming the narrower range of ethylene oxide content of at least 2.5%.

Again, in WO 555 there is no actual disclosure of a range or minimum amount of ethylene oxide, either based on the amount of the component (b) or in the composition as a whole. There is only the hypothetical range of 0.01 to 27% and the examples at values of 2.22% or lower.

The examples in the present application demonstrate that the adhesive composition according to the invention, with an ethylene oxide content of more than 2.5% (Example 1) had "significantly faster" in the reactivity test as compared to adhesive compositions corresponding to those of WO 555 (with ethylene oxide contents of 2.2% - Comparative Example 2a or 1.6% - Example 2b) (*see,* page 10 line 16 to page 11, line 21 for the examples; page 12, line 30 to page 13, line 2 for the results). This result would not have been expected from the disclosure of WO 555 since there is no suggestion in the reference that at higher amounts of ethylene oxide the reactivity test would be higher than at lower amounts of ethylene oxide.

Therefore, it must be concluded that there is no disclosure, of sufficient specificity, in WO 555 to constitute an anticipation of a moisture-activated adhesive composition as set forth in claims 1-17, which includes the reaction product of (A) (a) a blend of polymeric MDI and pure MDI or (b) an isocyanate terminated prepolymer; and (B) an isocyanate-reactive component wherein the total ethylene oxide content is more than 2.5% relative to the total adhesive composition. Furthermore, the results achieved by following the disclosure of the present application would not have been expected based on the disclosure of WO 555.

Accordingly, Applicants respectfully submit that the disclosure of WO 555 does not anticipate (or make obvious) the present invention and that the final rejection of claims 1-17 should be withdrawn and the application passed to issue.

Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned attorney for Applicants at the telephone number indicated below in order to expeditiously resolve any remaining issues.

Respectfully submitted,

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Date: September 18, 2003
Attachment: U.S. Patent No. 6,368,714